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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,330	07/23/2003	Takahiro Tanaka	2562/69798/JPW/FHB	7771

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New York, NY 10036

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,330

Applicant(s)

TANAKA, TAKAHIRO

Examiner

John m. Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2 shts.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' claims are confusing as to intent because it can not be determined if the processes as claimed, defined by the language "...is enabled to be formed without...", are inclusive of methods of preparation including cell-opening operations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama et al.(4,264,743).

Maruyama et al. disclose preparations of flexible open-celled polyurethanes having low-air permeability and being formed from feedstock including polyols,

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isocyanates, catalysts, foaming agents, oxyalkylene-siloxane foam stabilizers, and hydrocarbon fluid compounds which read on the processes and products claimed (see column 4 line 17 - column 8 line 36, column 5 line 50-59, column 9 lines 20-29, and column 16 lines 64-65, as well as, the examples, and the entire document).

Claims 1-9 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al. (6,034,148).

Kelly et al. disclose preparations of flexible open-celled polyurethanes having low-air permeability and being formed from feedstock including polyols, isocyanates, catalysts, foaming agents, oxyalkylene-siloxane foam stabilizers, and additives which read on the processes and products claimed (see the entire document).

Claims 1-9 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly (6,747,068).

Kelly et al. disclose preparations of flexible open-celled polyurethanes having low-air permeability and being formed from feedstock including polyols, isocyanates, catalysts, foaming agents, oxyalkylene-siloxane foam stabilizers, and additives which read on the processes and products claimed (see the entire document).

Claims 1-9 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Yata et al.(5,550,169).

Yata et al. disclose preparations of flexible open-celled polyurethanes having low-air permeability and being formed from feedstock including polyols, isocyanates, catalysts, foaming agents, oxyalkylene-siloxane foam stabilizers, and additives which read on the processes and products claimed (see the entire document).

Claims 1-9 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-7188644, JP3068677, JP57031976, JP57102978, JP9053061, JP8092404, and EP0806442, each taken individually.

JP-7188644, JP3068677, JP57031976, JP57102978, JP9053061, JP8092404, and EP0806442, each taken individually, disclose preparations of flexible open-celled polyurethanes having low-air permeability and being formed from feedstock including polyols, isocyanates, catalysts, foaming agents, oxyalkylene-siloxane foam stabilizers, and additives which read on the processes and products claimed (see the entire document).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

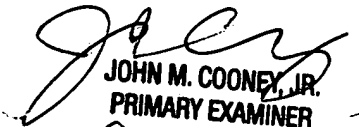
Claims 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al., Kelly, Yata et al., JP-7188644, JP3068677, JP57031976, JP57102978, JP9053061, JP8092404, and EP0806442, each taken individually {hereon referred to as PRIMARY} as applied to claims 1-9 and 19 above, and further in view of Maruyama et al.

PRIMARY differ from the claims in that the hydrocarbon compound claimed is not particularly recited as an additive. However, Maruyama et al. teaches the employment of these materials in polyurethane synthesis for the purpose of improving imperviousness and waterproofing of articles formed (see column 4 line 17 - column 8 line 36, column 5 line 50-59, column 9 lines 20-29, and column 16 lines 64-65, as well as, the examples, and the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed the hydrocarbon compounds of Maruyama et al. in the preparations of PRIMARY for the purpose of imparting its permeability reducing effect in order to arrive at the processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
